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10/674,054

09/29/2003

Jeffrey Taylor

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Saul Ewing LLP (Philadelphia)

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EXAMINER

THOMPSON, MICHAEL M

ART UNIT

PAPER NUMBER

3629

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/674,054

Applicant(s)

TAYLOR ET AL.

Examiner

Michael M. Thompson

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-893)
- Paper No(s)/Mail Date 7-22-04

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date: ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 1-16 and 25-36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

3. The first step in determining whether a claim recites patent eligible subject matter is to determine whether the claim falls within one of the four statutory categories of invention recited in 35 USC 101: process, machine, manufacture and composition of matter. The latter three categories define "things" or "products", while a "process" consists of a series of steps or acts to be performed. For purposes of 101, the analysis of a process is guided by the machine-or-transformation test. *In re Bilski*, ___ F.3d ___ (Fed. Cir. 2008)(en banc).

4. Based on Supreme Court precedent (*Diamond v Diehr*, 450 U.S. 175,184 (1981); *Parker v. Flook*, 437 US 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent precedent from the Federal Circuit from *In re Bilski*, the machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. See *Benson*, 409 U.S. at 70. Certain considerations are applicable to analysis under either branch. First, as illustrated by *Benson*, the use of a specific machine or transformation of an article must impose meaningful limits on

the claim's scope to impart patent-eligibility. See *Benson*, 409 U.S. at 71-72. Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. See *Flook*, 437 U.S. at 590. If neither of these requirements is met by the claim, the method is not a patent eligible process under 35 U.S.C. 101.

5. **Claims 1-16 and 25-36** are drawn to a **method of predicting the geographic location of a user**. All of the recited method steps can be performed by the user themselves, in the mind of the user or between different users through writing by a user, and therefor these method steps are not tied to a particular machine nor do they transform an article. To qualify as a statutory process, the claim should positively recite in the body of the claim, the machine to which it is tied. For example, by identifying the machine that accomplishes the method steps, or positively reciting the article that is being transformed.

6. Please note that ***nominal recitations of a machine in an otherwise ineligible method fail to make the method a statutory process***. See *Benson*, 409 U.S. at 70 -72. As *Comiskey* recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." *Comiskey*, 499 F.3d at 1380 (citing *In re Grams*, 888 F.2d 835, 839-40 (Fed. Cir. 1989)). Incidental physical limitations, such as data gathering, field of use limitations, storing, collecting, sending, receiving, and other forms of insignificant extra solution activity are not enough to convert an abstract idea into a statutory process. In other words, nominal or token recitations of involvement of a

machine or transformation in a method claim do not convert an otherwise ineligible claim into an eligible one. *Ex parte Langemyr* (2008) and *In re Bilski*, (Fed. Cir. 2008)

7. Therefore, the applicable test to determine whether a claim is drawn to a patent-eligible process under § 101 is the machine-or-transformation test set forth by the Supreme Court and clarified herein, and Applicants' claim here appears to fail this test. No new matter should be added.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. **Claims 1-6, 9-10, 17-21, 25, and 29-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Goeller et al. (US 7,200,658).**

10. **With respect to claims 1, 17 and 25**, Goeller et al. teaches a method of predicting the geographic location of a user of a communication network based on the user's network address, the method comprising the steps of: (1) obtaining and storing data purportedly disclosing the geographic location of a plurality of users of the network; (i.e. ICAAN database) (2) obtaining and storing the network addresses of the plurality of users; (i.e. Geo filtering server) and (3) correlating the geographic location data with the network address data (i.e. the Advanced Geo-Filtering agent) to

generate data predicting the geographic location of a user of the network as a function of the network address through which the user accesses the network and predicting the user's geographic location.

With respect to claim 17, the Goeller et al. process is stored on computer medium as shown in the figures.

With respect to claim 25 and those claims that depend from it, Goeller et al. also teaches (4) when a user of the network visits the website, predicting the user's geographic location based on the predictive geographic location data. (i.e., this is the main purpose and role of the Goeller et al. patent.

11. **With respect to claims 2 and 18**, Goeller et al. teaches the method of claim 1 wherein the predictive data comprises, for each network address, a predicted geographic area and a rating of the likelihood that the predicted geographic area accurately reflects the geographic location of users who access the network through that network address. Given the language set forth in claim 1, these limitations are considered a further recitation of the intended use, in connection with the step of correlating geographic location data. In a claim drawn to a process of predicting, the intended use must result in a manipulative difference as compared to prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). Therefore, the instant claim has not been given patentable weight. Furthermore, the specific composition of the predicative data is deemed to be nonfunctional descriptive material and is not functionally involved in the steps recited. The obtaining, storing and correlating steps would be

performed the same regardless of what type of predicative data it is. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) and MPEP 2106.01.

12. **With respect to claim 3 and 19**, Goeller et al. teaches the method of claim 2 wherein the predictive data comprises, for each network address, a plurality of overlapping predicted geographic areas of increasing size, and, for each such geographic area, a rating of the likelihood that the predicted geographic area accurately reflects the geographic location of users who access the network through that network address. As per claim 3, this claim similarly rejected over that of claim 2 under a similar rational. The claim furthers the intended use and would similarly be considered a nonfunctional recitation.

13. **With respect to claim 4**, Goeller et al. teaches the method of claim 3 wherein said plurality of geographic areas of increasing size comprise at least a city and a state. As per claim 4, this claim similarly rejected over that of claim 3 under a similar rational. The claim furthers the intended use and would similarly be considered a nonfunctional recitation.

14. **With respect to claim 5**, Goeller et al. teaches the method of claim 1 wherein said geographic location data comprises one or more of a home or business address and a telephone number. (i.e. In the least addresses (postal) are taught at col. 2, line 53- col. 3, line 5). Regardless, the specific composition of the geographic location

data is deemed to be nonfunctional descriptive material and is not functionally involved in the steps recited. The obtaining, storing and correlating steps would be performed the same regardless of what type of geographic location data it is. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) and MPEP 2106.01.

15. **With respect to claims 6 and 29**, Goeller et al. teaches the method of claim 1 and 25 wherein step (1) comprises obtaining said geographic location data voluntarily from said users. (i.e. this is inherent in the data collection of Goeller et al. since users who use the internet and fail to block, hide, or secure their identifiable information such as through their IP address or browser, are voluntarily offering the data.)

16. **With respect to claims 9, 21 and 30-31**, Goeller et al. teaches the method of claim 1 and 25 wherein said geographic location data comprises the users' self reported addresses. As per claims 9, 21 and 30 these claims are similarly rejected over that of claim 6 under a similar rational.

17. **With respect to claims 10 and 32**, Goeller et al. teaches the method of claim 1 wherein step (2) comprises reading and storing at a node of the network the network address of users who access data at that node through the network. (i.e. node address storage is taught on Figure 5, col. 2, lines 53- col. 3 line 5 and col. 5)

18. **With respect to claim 20**, Goeller et al. teaches the product of claim 19 wherein said plurality of geographic areas of increasing size comprise at least a city,

a state, and a country. Goeller et al. explicitly teaches a plurality of geographic areas of increasing size of a city, state and country. In addressing the geographic area of the country, Goeller et al. teaches the United States as a geographic region.

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 2-3, 11-13, 18-19, 22-23, 27-28 and 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goeller et al. in view of Hampton (US 7,062,572).

21. **With respect to claims 11, 22 and 33** Goeller et al. teaches all of the limitations of the method in claims 1 and 17 respectively, except for explicitly reciting further comprising the steps of: (4) obtaining data indicative of the integrity of the geographic location data; and wherein step (3) further comprises further correlating the geographic location data and network address data with the integrity data to generate a rating of the likely accuracy of the predictive geographic location data. Hampton teaches mapping the geographic location of an internet user by an IP address based on data of stored IP addresses and corresponding mapping requests that are accompanied by an accuracy rating or confidence factor. It would have been obvious to one of ordinary skill in the art to have modified the Goeller et al. process for determining location and mapping of internet users with the ability to determine the

accuracy or confidence of the results with data that is indicative of the integrity of the geographic location as taught by Hampton merely for providing greater accuracy and assurance in determining the geographic location as taught by the reference. It should be noted that despite the Examiner's rejection, the language directed to generating a rating and claim 12 are considered intended use of the data correlation.

22. **With respect to claims 2-3, 12, 18-19, 23, 27-28 and 34,** Goeller et al. teaches the method of claims 1, 11; 17, 22; and 25 respectively, except for explicitly reciting that the predictive data comprises, for each network address, a plurality of overlapping predicted geographic areas of increasing size, and, for each such geographic area, a rating of the likelihood that the predicted geographic area accurately reflects the geographic location of users who access the network through that network address. In the least, Goeller et al. explicitly teaches a plurality of geographic areas of increasing size of a city, state and country, while Hampton teaches the rating as in claim 11 above. These claims may be similarly rejected under the combination of claim 11 as well.

23. **With respect to claim 13,** Goeller et al. teaches the method of claim 11 wherein step (1) comprises obtaining said geographic location data voluntarily from said users. As per claim 13, this claim similarly rejected over that of claim 6 and 9 under a similar rational.

24. **With respect to claim 26,** Goeller et al. teaches the method of claim 25, except for explicitly reciting the method further comprising the step of: (5) providing geographically targeted advertising to users who visit a website on the internet based

on the predictive geographic location data. Hampton teaches providing geographically targeted advertising. It would have been obvious to one of ordinary skill in the art, at the time of invention, to have modified the Goeller et al. reference to include geographically targeted advertising as taught by Hampton for the well known purpose of marketing products in different geographic regions, for example, specific to the regional sales and or stores to provide an enhanced shopping experience and to provide regional advertising similar to well known mail circulars to increase sales and patronage.

25. Claims 7-8, 14, 16, 27 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goeller et al. in view of Hampton and further in view of Black et al. (US 2003/0023541).

26. With respect to claim 7-8, 14, and 27, Goeller et al. and Hampton teach the method of claims 7 and 13, except for explicitly reciting the steps of operating a website on the Internet and asking users of the website to self report information indicative of their geographic locations. Black et al. teaches the self reporting of information such as your shipping or billing address in order to make a purchase over the website. It would have been obvious to one of ordinary skill in the art, at the time of invention, to have modified the combination of Goeller et al. and Hampton to further comprises the ability to provide the user to self report their shipping or billing address that is indicative of their geographic location for the well known purpose of confirming the billing information and/or shipping information. Specifically with respect to claims

7 and 8, the reporting of the geographic location is inherent in providing the billing/shipping address.

27. **With respect to claims 16 and 36**, Goeller et al., Hampton teach all the limitations of claims 1, 12-14 and 25-27 respectively, except for explicitly reciting that an entity sells goods via the website and requires a user, when purchasing goods, to self report an address to which the user wishes the goods to be shipped and a payment vehicle to which the cost of the goods is to be charged and wherein the integrity data comprises a rating based on a correlation of the self reported ship to address and a billing address for the payment vehicle. Black et al. teaches the self reporting of information such as your shipping or billing address in order to make a purchase over the website. He also teaches the merchant comparing the shipping and billing address for the purposes of security in the transaction the rating being a confirmation or hold on the purchase for the purpose of security. It would have been obvious to one of ordinary skill in the art, at the time of invention, to have modified the combination of Goeller et al. and Hampton to further comprises the ability to provide the user to self report their shipping or billing address that is indicative of their geographic location, and to provide a system of billing and shipping address comparison by a merchant for the well known purpose of confirming the billing information and/or shipping information and the security or integrity of the purchaser in a transaction.

28. **Claims 15, 24, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Goeller et al. and Hampton in view of Black et al. (US 2003/0023541) and further in view of Klingman (US US 5950172).**

29. **With respect to claims 15, 24 and 35,** Goeller et al., Hampton and Black et al. teach all the limitations of claims 1, 12-14; 17, 22-23 and 25-27 respectively, except for explicitly reciting that the website provides a service whereby users of said website transact business with other users of said website and further wherein users of said website provide feedback information to said website about other users of the website with whom they have transacted business indicative of the integrity of the other users and wherein the integrity data comprises said feedback information. Klingman teaches the use of a feedback system for providing feedback information on the integrity of it's users. It would have been obvious to one of ordinary skill in the art, at the time of invention to have modified the combination of Goeller et al., Hampton, and Black et al. with a feature to provide feedback on other users as taught by Klingman for the well known purpose of providing feedback on the services provided from retailers or from sales of other users to better serve the public and provide information on the potential reliability of service rendered.

Conclusion

30. The Examiner has pointed out particular references contained in the prior art of record, within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may

apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael M. Thompson whose telephone number is (571) 270-3605. The examiner can normally be reached on Monday thru Friday 8am-5:30 except Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael M Thompson/
Examiner, Art Unit 3629

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/John G. Weiss/

Supervisory Patent Examiner, Art Unit 3629